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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030.287	07/22/2002	CLAUDIO TORGHELE	946999.00002-5	9000

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08/27/2004

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EXAMINER

COOLEY, CHARLES E

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,287	TORGHELE ET AL. S.A.	
	Examiner	Art Unit	
	Charles E. Cooley	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-23, 25-27 and 29-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-23, 25-27, 29-38, 40 and 41 is/are allowed.
- 6) ☒ Claim(s) 15-17, 39 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112, first paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure and the specification, as originally filed, does not provide support for the invention as is now claimed.

3. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for the recited "means for preparing a dough mixture by rotating the kneading element at a lower speed to form and roll together dough clumps", "means for preparing the dough by rotating the kneading element at an even lower speed to roll out and roll thin the dough", or "means for forming a single, compact, balled together dough mass by rotating the kneading element at a lowest speed". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims are not supported by an enabling disclosure because the person skilled in the art would not know how to

make or use the invention without a description of elements to perform the function (MPEP 2185).

35 U.S.C. 112, ¶6 states that "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function, without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

While 35 U.S.C. 112, ¶6 permits a particular form of claim limitation, it cannot be read as creating an exception either to the description, enablement or best mode requirements of the first paragraph or the definiteness requirement of the second paragraph of 35 U.S.C. 112. *In re Knowlton*, 481 F.2d 1357, 178 USPQ 486 (CCPA 1973).

Claim 39 recites a "means" for performing a specified function as outlined above and the examiner is treating such recitations under 35 U.S.C. 112, ¶6 pursuant to the "Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, ¶6", USPTO, 65 FR 38510, 38514 and MPEP 2181. However, the specification is devoid of the corresponding structure that performs the functions recited in claim 39. The instant specification does not set forth the structure corresponding to the means-plus-function claim limitations in claim 39. In *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997) the Federal Circuit stated that "structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the

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function recited in the claim. This duty to link or associate structure to function is the quid pro quo for the convenience of employing Section 112, Para. 6." Since no corresponding structure has been linked to the functions in the means-plus-function limitations of claim 39, the specification does not provide enablement for the recited "means for preparing a dough mixture by rotating the kneading element at a lower speed to form and roll together dough clumps", "means for preparing the dough by rotating the kneading element at an even lower speed to roll out and roll thin the dough", or "means for forming a single, compact, balled together dough mass by rotating the kneading element at a lowest speed". It appears the sole kneading element (4) performs each of these functions in cooperation with a particular rotational speed yet there exists no plurality of kneading elements linked to each of these functions and the specification is devoid of means for controlling the speed of the kneading element. In any event, the specification is silent with respect to the particular means capable or performing the functions recited in claim 39.

4. The limitation in new claim 42 regarding the two flat surface sections being located within the common radius about the rotational axis of the housing is not supported by the originally filed disclosure or drawings. The specification is silent with respect to this limitation and the drawings fail to support the limitation as it clearly appears that a significant portion of the flat surface sections are located outside the common radius.

5. Claim 42 is therefore rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 U.S.C. § 112, second paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 15-17 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, line 8: "the kneading element" lacks antecedent basis. Note the kneading element is set forth in the last section of the claim as amended.

Claim 16, line 8: "the kneading element" lacks antecedent basis. Note the kneading element is set forth in the last section of the claim as amended.

Claim 17, line 8: "the kneading element" lacks antecedent basis. Note the kneading element is set forth in the last section of the claim as amended.

8. Since no corresponding structure has been linked to the functions in the means-plus-function limitations of claim 39 as explained above, the claim is indefinite. *In re*

Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997) and see MPEP 2185.

9. Each pending claim should be thoroughly reviewed such that these and any other informalities are corrected so the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Newly presented claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (US 5,322,368).

The patent to Tanaka et al. discloses a dough mixer comprising a housing 2 having two circular, juxtaposed, and separated surfaces connected by two curved and separated casing surface sections defined by a common radius about a rotational axis of the housing 2 (Figures 1-2); two flat surface sections 24 and 30 between and connecting the two curved casing surface sections, wherein the flat surface sections are located within the common radius about the rotational axis of the housing (Fig. 1); and a kneading element 12 operating about the rotational axis of the housing.

Allowable Subject Matter

12. Claims 15-17 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.
13. Claims 18-23, 25-27, 29-38, and 40-41 are allowable over the prior art of record.

Response to Amendment

14. Applicant's arguments with respect to the pending claims have been considered but are deemed to be moot in view of the new grounds of rejection necessitated by amendment. Claim 39 is not enabled by the instant disclosure and should be cancelled to expedite prosecution. New claim 42 is considered to involve new matter and is anticipated by the disclosure of Tanaka as outlined above.

The substitute specification and abstract filed 2 JUL 2004 are approved and have been entered.

Conclusion

15. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT

MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "Charles", followed by a long, horizontal, wavy flourish.

Charles E. Cooley
Primary Examiner
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24 AUG 2004